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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/112,131

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JAY S. WALKER

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WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

NGUYEN, CUONG H

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 04/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/112,131

Applicant(s)
Walker et al.

Examiner
Cuong H. Nguyen

Art Unit
2165



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 4, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 177-189 and 193-195 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 177-189 and 193-195 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

DETAILED ACTION

1. This Office Action is the answer to the RCE, the preliminary response, and the affidavit received on 1/04/2002 which papers have been placed of record.
2. Claims 177-189, and 193-195 are pending in this application.

Response:

3. This is a response to an RCE of applicants' earlier Application No.09/112,131. (Applicants' affidavit said a date of conception for this application was "before" 2/27/1996; but the evidence in that paper (about the pending application's subject matter) is very abstractive and it was not sufficient for the reason of "reduction to practice" with that submitted evidence (just 2-3 lines !!! it really was an incomplete invention). If something has been reduced to practice, surely other technologists need not perform further experimentation to ensure that it works, this is not the same situation here; furthermore, USPTO 's hierarchy was given in previous Office Action, furthermore, a very familiar evidence in daily life is **Yellow Pages** also read-on the claimed subject matter. Applicants also failed to provide the above affidavit when responded to an earlier Office Action mailed 12/06/2000 wherein **Nielsen's** reference was first applied in the rejections).

A. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998), the court ruled: "The name of the game is the claim".

Therefore, claim's languages are very important, accordingly they are reasonably interpreted in examination process.

B. Referring to the argument on the paper received on 4/09/2001 (page 3, 2nd paragraph), that "...nothing in **USPTO procedure** entails the claimed steps of "receiving a first expert "qualification" corresponding to the first expert", nor "transmitting the first expert "qualification" to a second expert", nor "receiving a "signal" from a second expert that indicates approval of the first expert "qualification", the examiner submits that these kinds of actions have been widely used in many areas (**USPTO might not expressly say that limitation exactly as claimed languages, neither published those ideas**, but in its telephone directory, as an example, clearly showing a hierarchical order that reflecting above limitations, i.e., art unit 705, sub-class 26 defined the listed examiners having "e-shopping" knowledge/skills to examining this kind of specific cases, the supervisor of this art unit (A.U. 2165) has a senior level of patent examining functions and familiarity with this skill levels; accordingly, she is the right one to give a second/first opinion about a claimed limitation; furthermore, a director (as her boss) has more of this particular skills comparing to an ordinary examiner or a supervisor in these group art units. Upon making decision about a consulted matter, a "YES" or "NO" answer

has been given (this may be in oral, or in writing, or using an e-mail; equivalent to a communicating "signal"). **USPTO** 's method of doing business would be related to "expert qualification" comprising a first expert (examiner) and a second expert having authority to approve the first expert "qualification" (his supervisor). This has widely used/been available in public knowledge; this idea of doing business from **USPTO** would be implemented in cited references by one of ordinary skills in the art, it comprises hierarchical authorities. Moreover, in re **Susi**, 169 USPQ 423 (CCPA 1971), the court ruled: Disclosed examples do not constitute a teaching away from a broader disclosure or non-preferred embodiments.

C. "Furthermore, the **Harte** reference, being concerned with an instructional and testing device, has nothing to do with the claimed subject matter of a computer implemented expert matching method. In any case, **Harte** certainly does not supply the element, lacking in the other art cited by the Examiner, of receiving a "signal" from a second expert that indicates approval of a first expert "qualification". The examiner submits that **Harte**'s patent was submitted as an IDS (containing only that single reference) to PTO on this case for consideration. It was very surprised if this reference has nothing to do with this application.

- Furthermore, see a well-known computer site of eBay.com for actions of: "...concerning steps of receiving a bid on an end user-request ..., ... transmitting such a bid ...".

Accordingly, the examiner submits that an ordinary skills in the art would be able to modify these "bidding" ideas in various subject matters using at least **eBay's** reference although only "objects" are used for this purpose (bidding has been used at least in "reverse auction" from a US Patent, and applicants should be aware of it because same assignee/inventor is on this application). A motivation for "bidding an expert"/"essentially bidding for an expert's SKILL" is to gain potentially capable people for a specific purpose; that is what has been widely applied (in "**head hunting**" recruitment) since the past.

D. When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. Cited prior art disclosed structures that meet the claimed limitations although the matter is expressed in different language, the examiner submits that it is analogous with many examples in real-life. See **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990).

E. Claims' language could be read-on by cited references and no reasonable distinguishing limitation has been made in claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

F. The examiner submits that all the limitations are not patentable since **they lack of inventive steps**, i.e.

"Receiving a "signal" from a 2nd expert that indicates approval of a first expert "qualification"" (in this case, just a "Y" or "N" "signal"); "allowing the end user to select an expert from the list" (4th para. Of page 4). The applicants argue "claim 193 is submitted as being patentable since its feature of allowing the end user to select an expert from a list is not taught or suggested by prior art"; actually, this analogous action is notoriously well-known: e.g., an end user select a specific expert from a telephone book such as a Yellow Page; wherein an action of selecting an expert (from a list) in a telephone Yellow Page is inherent).

4. "claim 195 is submitted as being patentable over the prior art by virtue of its recitation (???) of "**receiving** at least one **bid** on the end user request **from** the at least one **expert**" (key words are bold-faced), and "**transmitting** the at least one **bid** to the end user" (key words are bold-faced). As above, these limitations simply **lack of inventive steps** (analogous actions for these limitations would be inherent in newspaper "classified ads" wherein objects/experts were bargained/bidding from readers) (the examiner submits that an ordinary skills in the art would be able to modify these "bidding" ideas for various subject matters using at least **eBay's** reference although only "objects" are used for this purpose). A motivation for "bidding an expert"/"essentially bidding for an expert's SKILL" is to gain potentially capable people for a specific

purpose; that is what has been widely applied (e.g., in "head hunting" or **bidding a defense contract** (opinions are given from a variety of sources; 2nd sources/experts are among those contributing opinions) to select **from many different bids**) in the past.

5. It is reasonable that various modifications of prior art would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of these inventions. Although cited inventions may have been described in connection with specific preferred embodiments, it should be understood that their limitations as disclosed should not be unduly limited to such specific embodiments. Furthermore, in response to the amendment, the examiner submits court cases which are relevant to applicant's arguments.

6. In re **Sheckler**, 168 USPQ 716 (CCPA 1971), the court ruled: It is not necessary that a reference actually suggest changes or possible improvements which applicant made. The PTO can show that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the cited references.

7. In re **Bozek**, 163 USPQ 545 (CCPA 1969), the court ruled: "Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred."

8. **Merck & Co. Inc. v. Biocraft Laboratories Inc.**, 10 USPQ2d 1843 (CA FC 1989), the court ruled:

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

9. In re **Heck**, 216 USPQ 1038 (Fed. Cir. 1983), the court ruled: "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

10. In re **Keller, Terry, and Davies**, 208 USPQ 871 (CCPA 1981), the court ruled:

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."; and "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

11. In re **Conrad**, 169 USPQ 170 (CCPA 1971), the court ruled:

The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 177-189, 193-195 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Canale et al.** (US Pat. 5,619,648), in view of **Harte** (US Pat. 4,576,579).

A. Claims 177-178 are rejected because they "read-on" the steps of "expert matching" e.g. the USPTO Commissioner/the representative's attorney (the end user of a patent application), the examiner (an expert/master in his field by art unit/(classification subject), the Supervisory Patent Examiner (second expert who has a higher experience/authority compared to the first expert (his examiner). A patent application is transmitted to an examiner (first expert), he examines the case, and then get some advices from his SPE (second expert); this 2nd expert approves who is an appropriate person in his art unit for the job of examining this particular case (e.g. depending on a specific subject matter such as insurance, e-shopping, e-coupons, banking, .etc., he appoints one of his examiner who is expert in this specific field; the SPE is always a

senior, experience examiner who can guarantee his examiner's level of expertise to the Commissioner/the representative's attorney (the end user). Therefore, this rationale/reference would read-on the claim's language.

B. Referring to claims 193-195: The field of application is "expert matching" with assistance of a computer system (see in re **Lyell** for a case law of automation a known process, on this issue - a computer system is used to make that process organized and more accurate. An ordinary with skill in the art can simply look at the Yellow Pages to search for a specific expert, a corresponding address, a reference (this can be from a **more reliable** source standing for "2nd expert's opinion"; these actions can be done in his head or with a pencil and a pad .etc.)).

Canale et al. obviously suggest an expert matching computer for managing communications between an expert and an end user (see **Canale et al.'**648), the abstract; Figs.6, 7), comprising:

- inherent features of a controller unit for receiving an end user request (see **Canale et al.'**648), the controller unit having a database for storing therein a plurality of expert "qualification" (see **Canale et al.'**648), each expert qualification associated with an expert address stored in the database and corresponding to a particular expert (see **Canale et al.'**648);

- inherent features of a means for classifying request (see **Canale et al.'**648);

- inherent features of a means for providing an expert address which corresponds to a request's classification (see **Canale et al.** '648);
- inherent features of a means to identify:
 - an expert corresponding to a request's field/classification; an identified expert address corresponding to the identified expert (these features of the claim are **notoriously well-known** in the art (e.g. a Patent & Trademark Office's examiner on internal telephone books who examines applications of a particular US Classification (for example, class 705 subclass 28); his art unit, Technology Center, his phone number, his Office location .etc.; see also **Harte** for implicit suggestions);

Canale et al. ('648)/Yellow Pages may not disclose exactly a claim's language in using his concept as claimed by the applicants.

However, all the claimed limitations are analogously well-known in the above field. For example, a controller unit for receiving a request to grade a multiple choice test, it would define a testing level and selecting an appropriate test level questions (a requested expert qualification), this controller unit (computer using for testing) having a database for storing a plurality of test levels/(expert qualifications), each stored level/(different expert qualification) corresponding to an appropriate test/(expert of a plurality of sub-level experts), each stored test answer template/(expert qualification) being

associated with an address stored in the database and corresponding to a test/an expert .etc. (see **Harte** for these implicit suggestions). Then, these means are notoriously involved in this test:

- means for selecting/searching the database to identify a test/expert corresponding to the requested test/qualification and an address corresponding to the identified test (see **Harte** for these implicit suggestions);

- means for requesting management 's approval of a specific test (a standard of qualification) to a corresponding level of grade; and means to receive a response on that matter (this is analogous to "receiving a "signal" from the second expert (e.g. from manager) that indicates approval of the first expert qualification (a specific test)", and similar as above to "receiving a "signal" from the set of experts (e.g. many supervisors) that indicates approval of the first expert qualification") (see **Harte** for these implicit suggestions) (this response also answers arguments on para.2,4-5 of page 4 in the amendment received on 9/05/2000.

- means for authenticating data (e.g. checking tester's I.D., and picture I.D., checking authorized personnel in a test room .etc.);

- means for guaranteeing payment to the selected test (e.g., a test fee is administered in order to take the test or in order to have test results);

- means for initiating remittance of payment to a test (e.g., application accompanying a testing fee as initiation);

- means for selecting the end user requests for test evaluation (e.g. a teacher, a student, an employer);

- means for transmitting a portion of test result to the address corresponding to an identified result template (e.g. for adjusting the result in a test template);

- means for receiving a test answer/result in response to the end user request (this means is notoriously well-known in the art for receiving a test result (i.e. a student would receive a test result from a teacher));

- means for transmitting test answers to the end user (this means is notoriously well-known in the art for transmitting test answers e.g. to an employer, or "to whom it may concern");

In other words, these limitations can be done exactly by a computer system from a testing lab (see **Harte** for these implicit suggestions). One of ordinary skills in the art at the time of the invention would have found these claims' limitations would be very obvious with inherent steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior arts are also directed to a similar process for obtaining job applications from remotely located applicants. These prior arts are not limited to the described embodiments in these inventions. It is reasonable that

various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these inventions have been described in connection with specific preferred embodiments, it should be understood that the invention as claimed should not be unduly limited to such specific embodiments.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the same concept of testing a level/(an achievement) to perform functions as claimed; because all cited references would suggest using a similar means and applying a similar concept as a expert matching computer to select an appropriate source for a specific solution. A motivation for "bidding an expert"/"essentially bidding for an expert's SKILL" is to gain potentially capable people for a specific purpose; that is what has been widely applied (in "head hunting" recruitments) since the past.

C. Referring to claims 177-189: The limitations of these claims recite the same claim limitations as claims 193-195 discussed above. The same analysis and reasoning set forth above in the rejection for obviousness of claims 192-195 applied to these claims also because they are just computer and method claims for the above device; moreover these claims may have more broader limitations. The examiner considers specific limitations that the applicants said "significant limitations" are inherent/obvious in the

rationale/prior art in claim 177-189 since they are notoriously well-known in the business art.

Conclusion

13. Claims 177-189, 193-195 are rejected.

14. These provided references are considered pertinent to applicants' disclosure.

- **Nielsen** (US Pat. 5,948,054 filed on 2/27/1996) published on 9/07/1999, about a method and a system for facilitating the exchange of information between human users in a networked computer system.

- Esther **Dyson**, "Information, bid and asked", Forbes, v146, n4, p92(1), 8/20/1990; (from Dialog(R) file 47).

15. Remarks:

About automating a manual activity:

The court held that providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (using a computer "an automatic means" to "bid for expert" has been done manually in "head hunter"). *In re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958) Furthermore, the **Harte** reference, being concerned with an instructional and testing device, has nothing to do with the claimed subject matter of a computer implemented expert matching method..."

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is

09/112,131
Art Unit 2165

(703)305-4553. The examiner can normally be reached on
Monday-Friday from 7:15 AM-3:15 PM.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to: (703) 746-7239 (Official)

Or: (703) 746-5572 (RightFax) (for informal or draft
communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park
II, 2121 Crystal Drive, Arlington. VA. 22202, 4th. Floor.

Any inquiry of a general nature or relating to the
status of this application should be directed to the Group
receptionist whose telephone number is (703)305-3900.

Cuong Nguyen

Primary Examiner
Mar. 25, 2002